

REMARKS

Claims 1-7 and 10-13 have been examined and stand rejected. Claims 8 and 9 are hereby canceled without prejudice or disclaimer.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 10-13 under § 112, second paragraph, as being indefinite.

Applicants submit the present amendments to these claims obviate this rejection.

Claim Rejections - 35 U.S.C. § 102(b)

The Examiner rejected claims 1-6 under § 102(b) as being anticipated by Beck et al. (US 6,126,886).

Claim 1 recites, *inter alia*, wherein the ratio of a wall thickness of the thread forming region of the preform to the wall thickness of the threaded neck portion is about 4.09 - 5.59.

As disclosed in the specification, despite the strain hardening characteristics of PET, if this ratio is used, a small preform may still be blow out and result in usable threads on neck 12. (*Specification*, pp. 5-6)

In the rejection, the Examiner contends Beck discloses “wherein the ratio of a wall thickness of the thread forming region of the preform to the wall thickness of the threaded neck portion is about 4.71.” As the basis for this rejection, the Examiner contends that a comparison of FIGS. 1 and 3 appear to depict the claimed ratios. However, Applicants submit that Beck discloses no such feature. Furthermore, because the Examiner’s reliance on the figures is misplaced, Applicants submit this rejection is in error and should be withdrawn.

More specifically, “when a reference does not disclose that a drawing is to scale and is silent as to dimensions, arguments based on measurements of the drawing features are of little value.” (MPEP § 2125, *citing* Hockerson-Halberstadt, Inc. v. Avia Group Int’l, 55 USPQ2d

1487, 1491 (Fed. Cir. 2000)) (The disclosure gave no indication that the drawings were to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” (emphasis added))

Here, Beck is silent as to any particular dimensions of the preform illustrated in FIG. 1, and thus, the Examiner’s reliance on this figure, or FIG. 3 for that matter, is misplaced. Therefore, because the figures of Beck relied on by the Examiner fail to disclose the ratio features recited in amended claim 1, Beck fails to disclose all the features recited in the claim.

Thus, Applicants submit claim 1 is allowable for at least this reason.

Additionally, because the Examiner also relies on a similar comparison to disclose the features of claims 3 and 4, i.e. “wherein the ratio of the diameter of the thread forming region of the preform to the diameter of the finished threads is approximately 0.500 +/- .005,” Applicants submit claims 3 and 4 are allowable, for at least the same reasons set forth above with regard to claim 1.

Finally, Applicants submit claims 5 and 6 are allowable, at least by virtue of their dependency from claim 1.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 10 and 12 under § 103(a) as being unpatentable over Beck as modified by a comparison of Figures 1 and 3.

Specifically, the Examiner contends Beck discloses most of the features recited in claims 10 and 12, but concedes Beck fails to disclose that the preform wall thickness in a thread forming region is within the range of 0.1555-0.1790 inches. To compensate for this deficiency, the Examiner contends that a comparison of FIGS. 1 and 3 depicts that the ratio of the wall thickness

of the preform compared to the wall thickness of the finished container is around 4 or 5.

Therefore, the Examiner concludes, it would have been obvious to a person of ordinary skill in the art at the time of the invention to choose a preform wall thickness of approximately 0.15 to 0.18, as determined by routine experimentation, with the ratios and thicknesses depicted by Beck.

In response, Applicants submit the Examiner has failed to establish *prima facie* obviousness because the Beck fails to disclose, at least, “a thickness of a wall portion of the thread forming region of the preform is within the range of 0.1555-0.1790 inches,” as recited in claims 10 and 12, and additionally, the Examiner’s reliance on the figures and routine experimentation to arrive at this feature is improper.

First, the Examiner’s reliance on the figures for depicting a certain ratio is misplaced, as discussed above with regard to claim 1. No portion of Beck discloses that these figures are to scale, therefore, the Examiner’s reliance on the figures as disclosing the wall thickness ratio is improper.

Second, the Examiner’s reliance on routine experimentation to arrive at the recited range is also improper. “A particular parameter must first be recognized as a result-effective variable before the determination of the optimum or workable ranges of the variable might be characterized as routine experimentation.” (MPEP § 2144.05 (II)(B)) However, because Beck fails to disclose any particular parameter related to the preform dimension, the Examiner’s suggested modification of Beck in view of routine experimentation is wholly unsupported.

Because there is no basis for the Examiner’s purported modification of Beck, we propose submitting the Examiner has failed to establish *prima facie* obviousness. Thus, Applicants submit claims 10 and 12 are allowable, for at least this reason.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David P. Emery', is written over a horizontal line.

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